

Appl. No. 09/773,241
Atty. Docket No. 8409
Amdt. dated April 14, 2004
Reply to Office Action of Dec. 23, 2003
Customer No. 27752

REMARKS

Claims 1 - 19 are pending in the present application. No additional claims fee is believed to be due.

Claim 1 has been amended to correct the antecedent basis problem with the term "interior" and to put claim 1 in better form for appeal. Specifically, Applicants have deleted limitation c) because the limitation is not necessary to overcome the cited references. Support for these amendments can be found in Figures 1 and 3-9.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC 102 Over Aledo et al.

The Office Action has rejected claims 1-3, 5-10, 14, and 16-17 under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 4,850,988 issued to Aledo et al. But, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicant traverses the rejection by the Office Action because the cited reference fails to teach every element of the independent claim 1.

The Aledo et al. reference teaches a double fastening system with a cut therein. (Abstract). The Aledo et al. reference further teaches that a force transmission can be interrupted by forming two separate adhesive regions from an adhesive region system by providing a cut "which allows the resulting two adhesive regions to work independently from" one another. (See col. 1, lines 35-40). Also, the Aledo et al. reference teaches that the cut extends from the interior of the ear and transcends the outer edge of the ear forming the two separate adhesive regions. (See Figures 1-3).

In contrast, amended claim 1 recites, *inter alia*, that the side panel includes an "inner region having at least one discontinuity limited to the inner region." As shown in Figures 1 and 3-9, the discontinuity does not transcend the outer edge of the side panel, instead the discontinuity is fully contained within the inner region of the side panel. Because the Aledo et al. reference teaches a cut which extends from the interior of the ear and transcends the outer edge of the ear, the cut is not limited to the "inner region" of the side panel. Therefore, the cited reference fails to teach all of the elements of amended claim 1.

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Because the Aledo et al. reference fails to teach every element of amended claim 1, Applicants assert that claim 1 is not anticipated by the Aledo et al. reference. Therefore, Applicants assert that claim 1 is in condition for allowance. Furthermore, because claims 2-3, 5-10, 14, and 16-17 depend from claim 1, they too are not anticipated by the Aledo et al. reference and therefore, are in condition for allowance.

Rejection Under 35 USC § 103(a) Over Aledo et al.

The Office Action has rejected claims 4, 18, and 19 under 35 U.S.C. § 103(a) as being obvious in view of the Aledo et al. reference previously mentioned. In order to establish a *prima facie* case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.* Applicants respectfully traverse the rejection of the Office Action because the Office Action fails to establish a *prima facie* case of obviousness.

As discussed previously, the Aledo et al. reference teaches a cut which extends from the interior of the ear and transcends the outer edge of the ear as opposed to the discontinuity being limited to the inner region of the side panel as recited, *inter alia*, in claim 1. Thus, the cited reference does not teach or suggest all of the claim limitations of amended claim 1. Because claims 4, 18, and 19 depend from claim 1, the cited reference also fails to teach all of their claim limitations. Therefore, Applicants assert that claims 4, 18, and 19 are nonobvious over the cited reference and are in condition for allowance.

Rejection Under 35 USC 103(a) Over Aledo et al. in view of Zelazoski et al.

Claims 11-13 and 15 have been rejected under 35 USC 103(a) as being unpatentable over U.S. Pat. No. 4,850,988 issued to Aledo et al. in view of U.S. Pat. No. 5,536,555 issued to Zelazoski et al. Applicants respectfully traverse the rejection by the Office Action because there is no motivation to combine the cited references, and the cited references fail to teach all of the claim limitations of claims 11-13 and 15.

First, there is no motivation to combine the cited references. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." See *United States v. Adams*, 383 U.S. 39, 52 148 USPQ 479, 484 (1966). The degree of teaching is dependent upon the particular facts; however, "in

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general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." *Id.*

The Zelazoski et al. reference teaches a quilted film laminate having a plurality of slits through a film layer 12. (col. 4, lines 53-55). The film layer 12 is bonded to a substrate layer 14 which provides strength and caliper to the composite. (col. 5, lines 52-57). As discussed previously, the Aledo et al. reference teaches an adhesive region system which comprises two adhesive regions created by a cut which extends from an interior area of an ear and transcends the outer edge of the ear. (See Abstract).

The Office Action asserts that the motivation to combine these references exists because the quilted film laminate of the Zelazoski et al. reference "provides a good intake of liquids and resistance to rewet" and therefore can take the place of the ears of the Aledo et al. reference. (See Office Action page 8). However, the Aledo et al. reference makes no mention of multiple slits to accomplish its "two distinctive adhesive regions 15 and 16." (col. 3, lines 3-5). Therefore, one skilled in the art, upon reading the Aledo et al. reference, would be led on a path divergent from that followed by the applicant. Specifically, one skilled in the art would not use a plurality of cut lines to accomplish the two separate adhesive regions taught by the Aledo et al. reference. Because one skilled in the art would not make the suggested combination of references, there is no motivation to combine the cited references.

Second, assuming *arguendo* that there was motivation to combine the cited references, the cited combination still fails to teach or suggest all of the claim limitations of the claimed invention. For example, the suggested combination of references yields an ear which uses a quilted film laminate which has a plurality of adhesive regions which are formed by a plurality of slits which extend from an interior area of the ear and transcend the outer edge of the ear. Thus, the cited combination of references does not limit the discontinuity to the inner region of the side panel as recited, *inter alia*, in claim 1. Because claims 11-13 and 15 depend from claim 1, the cited combination does not teach all of their claim limitations either.

Because there is no motivation to combine the cited references and because the cited combination fails to teach all of the claim limitations of claims 11-13 and 15, the Office Action has not established a *prima facie* case of obviousness against these claims. Therefore, Applicants assert that claims 11-13 and 15 are nonobvious over the cited combination and are in condition for allowance.

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Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 102(b) and § 103(a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-19.

Respectfully submitted,

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